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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,512	03/07/2001	Gary L. Martin	24278	5298

7590

11/26/2002

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EXAMINER

CHAPMAN, JEANETTE E

ART UNIT

PAPER NUMBER

3635

DATE MAILED: 11/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/801,512

Applicant(s)

MARTIN, GARY L.

Examiner

Chapman E Jeanette

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitations of claims 7 and 9 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9, 19, 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9, 19, 39 recite "the elongated dimension" which lack a positive antecedent in the independent claim and it is unclear as to which element applicant is referencing; also confusing is the fact that applicant appears to be reciting a unitary structure, a different embodiment, when previously reciting a two part structure. The claim language basically has no clear meaning.

### ***Claim Rejections - 35 USC § 102***

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 10-11, 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Hellekson (3204374). Hellekson discloses an elongate continuous soffit panel having an adjustable width. The soffit panel comprises:

- a first member 12 having a soffit portion 12a/12a' having a proximal periphery 12b/12c and a parallel and spaced distal periphery 12d/e/f with a fascia portion 12f; the fascia portion extends generally upward to fasten the soffit to the roof; see figure 3, elements 28/12f;
- a second member 10 connected to the first member; the second member includes a flange 10b extending at an angle from the first member and used to fasten the panel to the side of the building 6

The second member is adjustably connected to the first member 12 (see figure 2) so that the width of the soffit panel is adjustable responsive to the variations in distance between the side of the building and the roof.

Claims ~~1-3, 5-6, 8-9, 10-13, 15-16, 18, 20-22, 24-25, 27-28, 31-33, 35-36, 39~~ are rejected under 35 U.S.C. 102(b) as being anticipated by Chalmers (4195455). (claim 9 is rejected as far as understood) Chalmers et al discloses an elongate continuous soffit panel having an adjustable width. The soffit panel comprises:

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- a first member 22 having a soffit portion 21 having a proximal periphery and a parallel and spaced distal periphery with a fascia portion 20; the fascia portion extends generally upward to fasten the soffit to the roof 14; see figures 1 and 8;
- a second member 24 connected to the first member; the second member includes a flange 18 extending at an angle from the first member and used to fasten the panel to the side of the building 11.
- the second member includes a channel for engaging the proximal periphery of the soffit portion 21; see figure 2; the soffit portion 26 includes holes for ventilation.
- The soffit panel comprises sheet metal which may be aluminum.
- The flange portion 18 and 20 extends upward from the soffit.
- Fastening the soffit panel to the building under a roof eave

The second member is adjustably connected to the first member so that the width of the soffit panel is adjustable responsive to the variations in distance between the side of the building and the roof.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 4, 7, 14, 17, 23, 26, 29-30, 34, 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chalmers et al in view of Meckstroth (5459965). Chalmers et al lacks the drip lip to prevent water from running along the soffit portion toward the side of the building

Meckstroth shows this structure in element 64; though any structure would be suitable which aided in water running away from the building. It would have been obvious to one of ordinary skill in the art to modify the base reference to include a drip lip in order to protect the building from the elements as shown by Meckstroth.

Chalmers also lacks the fascia portion dimensioned to serve as the roof fascia as also shown by Meckstroth. It would have been obvious to include the above structure on the soffit to Chalmers in order to provide some overhang for buildings without this structure as shown by the secondary references thus increasing the functionality or use of Chalmers.

Regarding forming the soffit panel on site for convenience: It would have been obvious to form the panel on or off site as it is known to form building elements using either method. The equipment to form the part still has to be available; another convenient method is shipping the part overnight or having it constructed locally. One of ordinary skill in the art would have appreciated constructing the panel in any suitable and convenient location conducive to the dates and times of completion for a project.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chapman E Jeanette whose telephone number is 703-

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308-1310. The examiner can normally be reached on Mon.-Fri, 8:30-6:00, every other fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Friedman , Carl can be reached on 703-308-0839. The fax phone numbers for the organization where this application or proceeding is assigned are 305-7687 for regular communications and 305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

jec  
November 12, 2002

  
Jeanette Chapman  
Primary Examiner